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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JOSEPH, TONYA S

ART UNIT	PAPER NUMBER
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3628

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/827,188	Applicant(s) FORRESTER, BRIAN	
	Examiner TONYA JOSEPH	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 18-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/19/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Applicant's election of Claims 1-17 in the reply filed on is acknowledged. Claims 18-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected method for maintaining accurate records and processing information, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/08/2007.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. Claims 1, 9 and 14 are directed to logic that is stated in claim 1 to be "embodied in a computer-readable medium." A "computer-readable medium" is defined in the Applicant's specification as "a magnetic signal capable of being transferred" (paragraph 15). Magnetic signals are not patentable subject matter under 101. Proper claims directed to computer-readable media must be limited to tangible storage media such as a hard disk or CD-ROM.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 1, 9 and 14 further recites the limitation, "retrieving instructions for retrieving/ receiving instructions for receiving...".The language is unclear. For Examination purposes, Examiner is interpreting the limitation to recite, "instructions for retrieving" as opposed to "retrieving instructions for retrieving".

7. Claim 1, 9 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the instructions for where the received updated meter information originates and/or the instructions for the updating the meter information. The claim as currently presented describes the first computer readable medium receiving the retrieved current utility information. The first computer readable medium then receives updated meter information concerning the upgrade of an old utility meter or an upgrade of an old meter with replacement components. It is not clear where the updated meter information originates, nor is it clear when the meter was replaced or upgraded with components. Appropriate correction is required.

8. Claim 1 recites the limitation, "a set of computer readable portable instructions embodied within said first computer readable medium". It is unclear what Applicant regards as "portable instructions". For Examination purposes, Examiner is interpreting instructions on a portable device as meeting this portion of the limitation of the claim.

9. Claims 1, 9 and 14 recite the limitation, "receiving said updated new meter information from said first computer readable medium representing upgraded old meters". The steps prior to this limitation state; **updated meter information includes:** new meter information or upgrading a meter with additional components. The first computer readable medium then transmits **the updated meter information**, including the new meter information or upgrading a meter with additional components to the host medium. However as the claim is currently presented the host computer readable medium **only receives** the new meter information, which is only one of the options presented and then at the same time this new meter information also represents upgrading old meters. This is confusing not only because upgrading old meters with additional components was presented in the alternative along with the new meter information 4 lines prior to this limitation, the first medium can send out two options, but the host medium can only receive one of those options. For Examination purposes, Examiner is interpreting the host medium to receive either the option in the alternative only.

10. Claims 1 and 14 recite the limitation "said current utility information" in line 31. There is insufficient antecedent basis for this limitation in the claim.

11. The term "logical sequence" in claim 2 is a relative term which renders the claim indefinite. The term "logical sequence" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For Examination purposes, Examiner is interpreting any sequence to be logical.

12. Claims 7 and 10 recite the limitation, "scanning the updated meter information...." Although, Applicant describes updated meter information as the new meter information or upgrading a meter with additional components to the host medium, it is unclear exactly what form the information is in (i.e. barcode, indicia etc.) and exactly what information is scanned. For Examination purposes Examiner is interpreting any scanned information as meeting the limitations of this claim.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-3, 5-6, 9, 11-12, 14-15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milman U.S. Pre-Grant Publication No. 2004/0014479 A1 in view of Hoffman et al. U.S. Patent No. 5,715,390.

15. As per Claims 1, 9 and 14, Milman teaches a first computer readable medium (see para. 6); a host computer readable medium with the ability to transmit data to and from said first computer readable medium (see para. 6 and para. 9); customer information embodied within said host computer readable medium containing current equipment information and location information for customers (see para. 28); a set of computer readable host instructions embodied within said host computer readable medium including:

instructions for retrieving said current equipment and location information for customers who have old equipment that require servicing (see para. 28)

instructions for transmitting said retrieved current equipment and location information to said first computer readable medium (see para. 28); and

a set of computer readable portable instructions embodied within said first computer readable medium including:

instructions for receiving said retrieved current equipment and location information from said host computer readable medium (see para. 9, 10 and 28);

instructions for receiving updated equipment information concerning the servicing of one of said equipment with new equipment or servicing said old equipment with additional components (see para. 30) and

instructions for transmitting said updated equipment information concerning the condition to said host computer readable medium (see para. 30);

said set of host computer readable instructions including:

instructions for receiving said updated new equipment information from said first computer readable medium; representing serviced equipment (see para. 30), and instructions for updating current equipment information with said updated equipment information in said customer information on said host computer readable medium.

Milman does not explicitly teach upgrading utility meters. Hoffman et al. teaches upgrading utility meters (see Col. 2 lines 16-29). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Milman to include upgrading utility meters to allow a utility company to provide greater flexibility

in metering electricity use, as taught by Milman Col. 2 lines 30-37. The limitation, “to reflect updated upgrade status” is merely a statement of intended result and as such is afforded little patentable weight. For all purposes in applying this combination of references, to dependent claims 2-8, servicing equipment will be interpreted as upgrading utility meters, as taught in Hoffman et al. in accordance with rationale stated above.

16. As per Claims 2 and 15, Milman in view of Hoffman et al. teach the system of claim 1 as described above. Milman further teaches wherein said set of host computer readable instructions includes instructions for creating route information representing a list of locations where equipment needs to be serviced arranged in a sequence based on said location information (see para. 9 and 28).

17. As per Claims 3 and 16, Milman in view of Hoffman et al. teach the system of claim 2 as described above. Milman further teaches wherein said set of host instructions includes instructions for transmitting said route information to said first computer readable medium (see para. 9).

18. As per Claim 5, Milman in view of Hoffman et al. teach the system of claim 3 as described above. Milman further teaches wherein said set of portable computer readable instructions includes instructions for displaying said route information (see para. 34).

19. As per Claims 6 and 12, Milman in view of Hoffman et al. teach the system of claim 1 as described above. Milman further teaches wherein said set of portable computer readable instructions includes: instructions for displaying a list of options;

instructions for receiving input representing a selection of a option from a user; and instructions for displaying output in response to said selection of option (see para. 36 and Figs. 9-17).

20. As per Claim 11, Milman in view of Hoffman et al. teach the system of claim 9 as described above. Milman further teaches wherein said set of portable computer readable instructions includes instructions for displaying said route information (see para. 34).

21. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milman U.S. Pre-Grant Publication No. 2004/0014479 A1 in view of Hoffman et al. U.S. Patent No. 5,715,390 in further view of Official Notice.

22. As per Claim 4, Milman in view of Hoffman et al. teaches the system of claim 3 as described above. Milman does not explicitly teach wherein said set of host instructions include instructions for converting said route information to a format recognizable by said first computer readable medium prior to transmitting said route information to said first computer readable medium. Official Notice is taken that converting information into a recognizable format prior to transmission is old and well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Milman and Hoffman et al. to include the teachings of Official Notice to enable reception by a receiving device.

23. As per Claim 17, Milman in view of Hoffman et al. teaches the system of claim 15 as described above. Milman does not explicitly teach wherein said set of host instructions include instructions for converting said route information to a format

recognizable by said first computer readable medium prior to transmitting said route information to said first computer readable medium. Official Notice is taken that converting information into a recognizable format prior to transmission is old and well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Milman and Hoffman et al. to include the teachings of Official Notice to enable reception by a receiving device.

24. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milman U.S. Pre-Grant Publication No. 2004/0014479 A1 in view of Hoffman et al. U.S. Patent No. 5,715,390 in further view of Gall et al U.S. Pre-Grant Publication No. 20030163831 A1.

25. As per Claims 7 and 10, Milman in view of Hoffman et al. teach the system of claim 1 as described above. Milman does not explicitly teach the limitation taught by Gall wherein said receiving instructions include scanning instructions for electronically scanning the updated equipment information into said first computer readable medium (see para. 37). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Milman and Hoffman et al. to include the teachings of Gall to facilitate troubleshooting, as taught in Gall para. 37.

26. Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milman U.S. Pre-Grant Publication No. 2004/0014479 A1 in view of Hoffman et al. U.S. Patent No. 5,715,390 in further view of Smith U.S. Pre-Grant Publication No. 2003/0220737 A1.

27. As per Claims 8 and 13, Milman in view of Hoffman et al. teach the system of claim 1 as described above. Milman does not explicitly teach the limitation taught by Smith wherein said set of portable instructions include GPS instructions for communicating with a Global Positioning system to obtain accurate information (see para. 25). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Milman and Hoffmann to include the teachings of Smith to verify the presence at the customer service location, as taught in Smith para. 25. The limitation, "for locating a utility meter".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TONYA JOSEPH whose telephone number is (571)270-1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tonya Joseph
Examiner
Art Unit 3628

/JOHN W HAYES/
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